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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,330	04/07/2004	Gregg D. Scheller	54084-47038	8512
21888 7590 08/07/2008 THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101				
EXAMINER				
DOWE, KATHERINE MARIE				
ART UNIT		PAPER NUMBER		
3734				
NOTIFICATION DATE		DELIVERY MODE		
08/07/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

Office Action Summary

Application No.

10/820,330

Applicant(s)

SCHELLER ET AL.

Examiner

KATHERINE M. DOWE

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-42, 47, 48, 51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-42, 47, 48, 51 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a complete response to the amendment filed 5/7/2008.
2. Claims 25-42, 47, 48, 51, and 52 are currently pending.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 25-34 and 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farzin-Nia (US 5,588,832). Farzin-Nia discloses the invention substantially as claimed including a microsurgical instrument comprising first (33) and second (34) microsurgical surfaces, means for manually moving the operative surfaces toward and away from each other (Fig 5), and a series of serrations (68) on the operative surfaces. The device is machined by wire electric discharge (col 3, ln 63). The first and second microsurgical surfaces form opposed jaws that are connected to an elongate rod (37). The jaws and rod are formed of a single piece of material (Fig 3; col 3, ln 45-46). The jaws may be considered forceps when used to grasp tissue and scissor blades when used to sever tissue (col 5, ln 5-11).

However, Farzin-Nia does not disclose the specific dimensions of the serrations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Farzin-Nia such that the width between adjacent peaks of the serrations was within the range of 0.0015 to 0.0039 of an inch, since the device is formed by wire electric discharge machining (col 3, ln 63) and it has

been held that where the general conditions of a claim are disclosed in the prior art, discovering optimum or workable ranges involves only routine skill in the art. See *In re Aller*, 105 USPQ 233.

5. Claims 35, 47, 48, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farzin-Nia (US 5,588,832), as applied to claim 30 above, in view of Toth et al. (US 5,584,845). Farzin-Nia disclose the invention substantially as claimed including a microsurgical instrument comprising first (33) and second (34) microsurgical surfaces, means for manually moving the operative surfaces toward and away from each other (Fig 5), and a series of serrations (68) on the operative surfaces. The device is machined by wire electric discharge (col 3, ln 63). The first and second microsurgical surfaces form opposed jaws that are connected to an elongate rod (37). The jaws and rod are formed of a single piece of material (Fig 3; col 3, ln 45-46). The jaws may be considered forceps when used to grasp tissue and scissor blades when used to sever tissue (col 5, ln 5-11).

However, Farzin-Nia does not disclose the specific dimensions of the serrations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Farzin-Nia such that the width between adjacent peaks of the serrations was within the range of 0.0015 to 0.0039 of an inch, since the device is formed by wire electric discharge machining (col 3, ln 63) and it has been held that where the general conditions of a claim are disclosed in the prior art,

discovering optimum or workable ranges involves only routine skill in the art. See *In re Aller*, 105 USPQ 233.

Additionally, Farzin-Nia disclose the pair of jaws (33, 34) and the elongate rod (37) are formed from the same material (Fig 3) by creating at least one slot. However, Farzin-Nia does not disclose the slot forms a pair of resilient spring arms at the rod distal end that connect the pair of forcep jaws to the rod. Toth et al. disclose a similar microsurgical instrument comprising first and second operative microsurgical surfaces (14-2) connected to a distal end of an elongate rod (14-1) where the rod and the operative surface are formed of the same material. Electric discharge machining is used to form a slot (14-3) in the rod to separate the operative surfaces as resilient spring arms (col 3, ln 5-16, 50-57; Figs 3A-3B). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Farzin-Nia such that a single rod with a longitudinal slot was used to form the rod and jaw portions of the device. Thus, the additional manufacturing steps of affixing jaw portions together with a pivot pin would be eliminated.

Response to Arguments

6. Applicant's arguments, see amendment, filed 5/7/2008, with respect to the rejection(s) of claim(s) 25-42, 47, 48, 51, and 52 under Hart (US 5,584,845) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Farzin-Nia (US 5,588,832).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KATHERINE M. DOWE** whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine Dowe
August 1, 2008

/K. M. D./
Examiner, Art Unit 3734

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773